

Remarks

This is a Response to the Official Action dated October 22, 2004.

Claims 1-42 are currently pending in the Application.

Non-statutory obviousness-type double patenting rejection

Applicant respectfully notes that the Examiner has raised a provisional non-statutory obviousness-type double patenting rejection, since the present application, Application Number 10/627,949 ('949), stands rejected in view of another pending application, Application Number 10/256,336 ('336).

Applicant respectfully requests that the provisional double patenting rejection be withdrawn and the present application be allowed since the provisional double patenting rejection is the only rejection remaining in the present application, see MPEP §804(I)(B), or since Claims 1-42 of the present application are patentable in view of Claim 19 of the '336 application for the reasons set forth below.

Claims 1-42 of the present application stand rejected under the judicially created obviousness-type double patenting doctrine in view of Claim 19 of the '336 application. Since the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination, see MPEP §804(II)(B)(1), Applicant submits that the Examiner has **not** established a *prima facie* case of obviousness for the claims rejected for double patenting. Applicant notes:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure"

(emphasis added) *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant submits that a *prima facie* case of obviousness has not been established for the reasons set forth below.

Applicant submits that the Examiner has failed to show that Claim 19 of the '336 application teaches or suggests each and every element as claimed in the present application.

Claim 1 of the present application:

Claim 19 of the '336 application generally recites "active device structures" while Claim 1 of the present application recites both "a plurality of individual semiconductor structures" and "particular ones of the individual semiconductor structures" (emphasis added).

It should be noted that step (c) of Claim 1 of the present application specifies a selection, in the sense that Claim 1 of the present application recites "a plurality of individual semiconductor structures" and "particular ones of the individual semiconductor structures," and "populating" step occurs with reference to the "particular ones of the individual semiconductor structures." To the contrary, in Claim 19 of the '336 application such selection does not occur, because the step of "fabricating" as recited in step (b) of Claim 19 of the '336 application refers to "active device structures" without a selection among structures being fabricated.

Hence, Claim 1 of the present application is patentably distinct from Claim 19 of the '336 application and should be allowed by the Examiner. Claims 2-25 of the present application depend from Claim 1 of the present application. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, in light of the above discussion of Claim 1 of the present application, Applicant submits that Claims 2-25 of the present application are also allowable.

Claim 26 of the present application:

Similar arguments apply to Claim 26 of the present application, where Claim 26 of the present application recites the “each type of semiconductor structure being fabricated with a corresponding geometric shape” (emphasis added).

It should be noted that step (c) of Claim 26 of the present application also specifies a selection, in the sense that “positioning” occurs with reference to “a receptacle having a shape complementary to the geometric shape of the semiconductor structure.” To the contrary, in Claim 19 of the ‘336 application such selection does not occur, because the step of “fabricating” as recited in step (b) of Claim 19 of the ‘336 application refers to “active device structures” without a selection among differently shaped structures.

Hence, Claim 26 of the present application is patentable over Claim 19 of the ‘336 application and should be allowed by the Examiner. Claims 27-42 of the present application depend from Claim 26 of the present application. Therefore, in light of the above discussion of Claim 26 of the present application, Applicant submits that Claims 27-42 of the present application are also allowable.

Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness for the claims rejected under for double patenting. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Conclusion

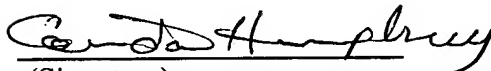
In view of the above, reconsideration and allowance of all the claims are respectfully solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on

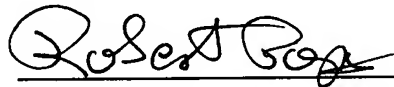
January 17, 2005
(Date of Deposit)

Corinda Humphrey
(Name of Person Signing)


(Signature)

January 17, 2005
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